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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,941	12/18/2000	Piotr Cofa	460-010020-US (PAR)	4785

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Clarence A. Green
PERMAN & GREEN, LLP
425 Post Road
Fairfield, CT 06430

EXAMINER,

PARTHASARATHY, PRAMILA

ART UNIT	PAPER NUMBER
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2136

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	09/739,941		COFTA ET AL.	
	Examiner		Art Unit	
	Pramila Parthasarathy		2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on October 06, 2006 have been fully considered.
2. Applicant's arguments with respect to 35 U.S.C. 112, first paragraph rejection is not persuasive. Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how and where the languages of the claims are supported in the specification.

Examiner hereby maintains 35 U.S.C. 112, first paragraph rejection.

Examiner explains that amended limitation and previously presented limitations "first call data", "second call data", "first tag" and "second tag" are not supported and described in the instant specification. Examiner suggests amending the claims with "auxiliary tags", "auxiliary code" and "digital signature" to explicitly recite the limitations. Examiner further explains that "in the call" in independent claims is not clear whether the limitation refers to the program call, first call or second call.

Applicant's arguments with respect to Claims 1 – 10 are not persuasive.

Applicant argues that the prior arts (Parthasarathy U.S. Patent Number 6,347,398) do not teach limitation "first and second tags" which are compared with "first tag of a program module and second call data transmitted in the call" (wherein the first tag data can identify the program module and the second tag data can be a digital

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signature which is used for identifying the manufacturer of the main program). Examiner would like to point out that Applicant has not explicitly claimed first and second tag in the amended claims set (and points out the difficulty in understanding the Claim limitations which are very broad), which now recite as "first call data" and further that "identifying the manufacturer of the program" is not recited in the independent amended claims.

With respect to "first tag" and "second tag" Examiner points to Column 8 lines 36 – Column 9 line 8) where Parthasarathy explicitly teaches software components are verified with the code verification module (identify the program module) and checking the digital signature in a digital certificate included in the downloaded software component. Furthermore, Parthasarathy anticipates and teaches that the invention can be used in cellular telephones, personal assistants and other wireless personal communications devices (WAP protocol).

With respect to Sites, Parthasarathy discloses first tag and second tag (see above) and Sites provides the motivation and teachings for encrypted program module. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Sites teaches

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securing and validating the trusted data and using that trusted data that is protected by digital signature.

Therefore, the examiner respectfully asserts that the cited prior art does teach or suggest the amended subject matter broadly recited in the independent claims. The dependent claims are rejected at least by virtue of their dependency on the dependent claims. Accordingly, the rejection for the pending claims 1 – 10 is respectfully maintained and new independent claims 11 and 12 are rejected on the same basis.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the second tag can be a digital signature that also verify that the manufacturer of the main program has approved the use of that particular program module with the main program) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner suggests applicant to amend the claims in a manner to distinct applicant's invention with prior art with **attention** given to the specification page 9 line 26 - page 10 line 32).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 – 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

4. Claims 1 – 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "wherein the tags" in "...wherein the tags are supplemented with second tags,....". There is insufficient antecedent basis for this limitation in the claim.

5. Claims 1 and 3 recite the limitation "said second call data " in "...the call is also supplemented with said second call data". There is insufficient antecedent basis for this limitation in the claim.

6. Dependent Claims are rejected based on their dependency from independent Claims.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1 – 3 and 6 – 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Parthasarathy et al. (U.S. Patent Number 6,347,398).

8. Regarding Claims 1 and 11, Parthasarathy et al. teaches and describes a method for binding a program module in a terminal, in which one or several programs are running, and in which method subroutines are stored in said program modules, the program modules are provided with first tags, wherein to start binding, the program makes a call to a subroutine, and the call is supplemented with the first tags to select the program module for binding, in which the called subroutine is stored, wherein the tags are supplemented with second tags, that the call is also supplemented with said second call data, and that in connection with the binding, said first tags stored in the program modules are compared with the first tags transmitted in the call, and the second tags are compared with the second call data transmitted in the call, and the program module to be bound is selected to be the program module which matches with

the first tags and the second call data transmitted in the call (Fig. 4; Column 2 line 58 – Column 3 line 21 and Column 8 line 10 – Column 9 line 8).

9. Regarding Claims 7 and 12, Parthasarathy et al. teaches and describes a terminal comprising means for binding a program module, which program modules contain stored subroutines and first tags, and which terminal also comprises means for running programs, means for standing binding by performing in the program a call to a subroutine, the call being supplemented with first call data to select that program module for binding in which the called subroutine is stored, wherein the program modules contain stored second tags; that the terminal also comprises means for adding second call data to the call, means for comparing said first tags stored in the program modules with the first call data transmitted in the call, means for comparing the second tags with the second call data transmitted in the call, and means for selecting a program module to be bound on the basis of said comparison (Fig. 4; Column 2 line 58 – Column 3 line 21 and Column 8 line 10 – Column 9 line 8).

10. Claims 2 and 8 are rejected as applied above in rejecting claims 1 and 7. Furthermore, Parthasarathy et al. teaches wherein the second tags to be formed in the program modules contain a digital signature (Column 9 lines 33 – 38).

11. Claims 6 and 10 are rejected as applied above in rejecting claims 1 and 7. Furthermore, Parthasarathy et al. teaches where program modules are stored in a

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server communicating with a digital network, wherein the terminal used is a mobile terminal and the binding of the program modules is performed at least partly by messages complying with the WAP protocol (Column 29 lines 3 – 29).

12. Claims 3 and 9 are rejected as applied above in rejecting claims 2 and 8.

Furthermore, Parthasarathy et al. teaches wherein the second call data are supplemented with a public key, on the basis of which the digital signature of the second call data formed in the program module is verified (Column 9 lines 33 – 38).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parthasarathy et al. (U.S. Patent Number 6,347,398) in view of Sites (U.S. Patent Number 6,728,880).

14. Claims 4 and 5 are rejected as applied above in rejecting claim 1. Although, Parthasarathy et al. teaches the program modules are stored and the second call data are supplemented with a public key, on the basis of which the second tags are formed in the program modules (Column 9 lines 33 – 38), Parthasarathy et al. do not explicitly disclose the second tags to be formed in the program modules are stored in an

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encrypted form. However, Sites discloses a system for providing trusted data (time), which is stored on the server that is protected by a digital signature (Sites Column 1 lines 24 – 32).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to store trusted data in the encrypted form to maintain integrity of trusted data. One of ordinary skill in the art would have been motivated to do this because it would validate the trusted data (second tags) and the integrity is confirmed, for example, decrypting the trusted data can only be done with a corresponding public key.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 1 – 12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 – 79 of U.S. Patent No. 6,394,341. Although the conflicting claims are not identical, they are not patentably distinct from each other because in the instant case all elements of claims 1 – 12 correspond to claims 1 – 79 of U. S. Patent No. 6,394,341, except in the instant claims the element digital signature is referred in claims of the Patent as electronic receipt with electronic signature. It would have been obvious to one having ordinary skill in the art to recognize that the digital signature is equivalent to the electronic receipt with the electronic signature, as digital signature is electronic signature.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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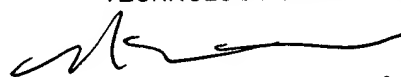
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-232-4195. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy
December 22, 2006.

NASSER MOAZZAMI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100


12, 23, 06